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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,437	07/26/2001	Yuji Taguchi	358362010500	4857

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT PAPER NUMBER

1752

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,437

Applicant(s)

TAGUCHI ET AL.

Examiner

Cynthia Hamilton

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-15, 17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 6, 16 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5, 7-8, 11-15, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Platzer et al (5,374,184) as optionally evidenced by Kelly et al (4,098,952) cited in penultimate line of column 4 of Platzer et al and Pears (4,391,767) cited in Example 1 in Platzer et al. The laminate of Example 1 to the point before the color layer is added anticipates the instant photosensitive resin laminate and plate for a signboard. The adhesive promoter is the instant adhesive layer and the composition of lines 55-66 in col. 8 is the uncolored polymerization layer

of Platzer et al and also inherently a transparent photosensitive layer. Thus, the laminate formed to this point by Platzer et al anticipates the instant laminate and plate set forth in applicant's claims 1-5, 7-8, 11-15 and 17. In Platzer et al, see particularly col. 4, lines 32-36, col. 4, line 56- col. 5, line 55, col. 8 lines 1-21 and Examples 2-8. Kelly et al is cited by Platzer et al as an example of an adhesion -promoting primer disclosed by Platzer as that of US No. 4,391,767, i.e. Pears.

1. Applicant's arguments filed December 3, 2003 have been fully considered but they are not persuasive. Applicants argue with respect to Platzer "The uncolored photopolymerizable layer only corresponds to the photosensitive resin layer of the present invention. Applicants claim a photosensitive resin laminate, which has specific light transmission characteristics." Applicants argue that because Platzer fails to describe or even mention the total light transmission of the photopolymerizable material and the film support together that Platzer does not describe or suggest a photosensitive resin laminate with the properties of instant claims 1 and 11. For this reason rejections in view of Platzer should be withdrawn. The examiner notes that it is the element of Platzer et al in Example 1 that is at issue. The examiner has held that the uncolored laminate, i.e. the uncolored polymerization layer on the biaxially stretched and heat - set polyethylene terephthalate film through which imaging will occur, is inherently possessed of the properties in question. The photosensitive layers must remain clear enough after imaging to allow the colored layer to be seen in the visible range. The examiner believes that the Platzer element is transparent at least in the sense it can be imaged and the photocured layer remaining be transparent enough to allow the color beneath to be seen. Thus, applicants' arguments as to what is taught by Platzer are not the issue. What is important is the actual characteristics of the

lamine in question of Platzer et al. Applicants only allege "Platzer fails to provide a photopolymerizable material which possesses light transmission properties within the claimed range." They present no evidence to support this allegation. Platzer et al in col. 1 do reference "colorless photoinitiators" to avoid shifting the color of the image. Platzer et al is trying to avoid discolorations in their materials. Thus, the examiner believes that she has presented enough evidence with respect to the element in question in Platzer et al to uphold the rejection at hand. The rejection stands.

1. Applicant's arguments filed December 3, 2003 with respect to "Claims 1, 3-5, 11 and 13-15 stand rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Trout" have been fully considered. Applicants amended claims 1, 3-5, 11 and 13-15 to a limit found in original claims 2 and 12 which were not rejected over Trout by the examiner in the last Office Action. Thus, the current claims have been amended as to limit their scope to that outside of Trout. The amended claims are not anticipated by Trout because applicants added "wherein the photosensitive resin layer has a thickness of not less than 500 μm ." Thus, Trout is no longer applicable to these claims due to applicant's amendments. Other arguments are not addressed because Trout is no longer an issue with respect to allowability. Applicants have limited their invention to exclude the elements of Trout by limiting the thickness of their photosensitive resin layers. The examiner has tacitly agreed this would overcome Trout in the last Office Action by not rejecting claims 2 and 12 over Trout originally. The issue of total light transmission of the Trout elements is not relevant to patentability in view of the thickness limitation set forth.

2. Hosokawa et al rejections are not repeated here in view of applicants pointing out that the layer thickness of Hosokawa et al excludes their teachings and elements from consideration. The examiner agrees the layer thickness limitation removes Hosokawa et al.
3. Claims 10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10 and 20 require that an image be on the "back of the support" but to that point what is back or front of the support has never been defined. Thus, what is meant by "back" with respect to the support is unclear. Is the back on the side opposite of the adhesive layer and/or the photosensitive resin layer? The examiner notes that the laminate of claim 1 does not require that the support, adhesive layer and photosensitive resin layer be assembled in any particular order. The examiner notes that claims 10 and 20 also require that "the layer having the image is that is required is that they be a photosensitive resin laminate. The same is true of all the other claims wherein no order is specified.
4. Applicant's arguments filed December 3, 2003 with respect to the indefiniteness of the "back of the support" have been fully considered but they are not persuasive. Applicants argue that "One of ordinary skill in the art would recognize that the back of the support is the side opposite the front of the support which includes the adhesive and/or the photosensitive resin layer. Accordingly, this rejection should be withdrawn." The examiner notes that applicants have not defined the "front" they allege a worker of ordinary skill would know was opposite the back. The examiner notes that applicants have not limited the location of the adhesive layer and/or the photosensitive resin layer to any one side of the support. Thus, applicants have not made clear where the front is with respect to the back and applicants have not made clear that the

back is not where the adhesive layer and/or the photosensitive resin layer is. Applicants have not even indicated that the adhesive layer is on the same side as the photosensitive layer in claim 1. There is no such limit in claim 9 or claim 10. There is no such limit in claim 19 or claim 20. Thus, the limit of "back of the support" in claims 10 and 20 in no manner limits the image to a different side of the support than the photosensitive resin layer or the adhesive layer. Claim 8 and claim 18 make the position of the photosensitive resin layer relative to the location of the adhesive layer and put both on one side of the substrate. No other claim is so limited.

Applicants are reading limitations into claims 10 and 20 that are not there. The rejection stands.

3. Claims 1-5, 8-15 and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Vreeland, Jr. et al (2003/0091802 A1). The laminate of claim 4 of Vreeland, Jr. et al anticipates the instant laminate of claim 1. The Example 1 laminate and photosensitive resin sign board of Vreeland, Jr. et al anticipates the instant laminate and signboard wherein the photosensitive resin laminate of Vreeland, Jr. et al inherently satisfies the formula (1) of instant claim 1 and inherently has the required Shore hardness, absorbance at 400 nm, scattering rate and turbidity.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

5. Applicant's arguments filed December 3, 2003 with respect to Vreeland, Jr. et al (2003/0091802 A1) have been fully considered but they are not persuasive. With respect to

Vreeland and claims 7 and 17, the examiner withdraws all but the rejections based upon inherency. She removes the issues under 35 USC 103 (a). The only issue remaining with respect to Vreeland Jr et al is whether the Example 1 laminate of Vreeland Jr et al anticipates the instant invention. Applicants again argue because the prior art does not identify the total light transmission characteristics of the laminate then the prior art cannot anticipate the instant invention. The examiner states that the laminate of Vreeland Jr et al only need have the characteristics. There is no requirement that the prior art teach the instant characteristics. Vreeland Jr et al do disclose that the obtained photosensitive resin layer precursor was "transparent and colorless" in paragraph [0043]. Applicants have presented no evidence to show the Vreeland Jr et al laminate has any less light transmission than the substrate that is part of it. The rejection above remains. Applicants have failed to show that the element in question does not inherently have the properties set forth.

6. The examiner agrees with applicants' characterization of Motoi et al and removes rejections based on Motoi et al for reasons set forth by applicant.

4. Claims 1-3, 7, 11-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hephher et al (4,041,204). The photosensitive sheet product of Hephher et al wherein the photosensitive coating layer is colorless as disclosed in col. 4, lines 21-37 makes obvious the instant laminate and plate wherein while the specific thickness of the photosensitive layer used in the laminate is not given, the examples give coating weights of 35 to 25 grams per square meter. This is held to fall inherently within the range of 1 mm or greater thickness for this layer as is required of the plate of instant claim 7. The choice of a colorless photosensitive layer is the choice of a clear layer. Since white layer is listed as an alternative to colorless in Hephher et al,

then colorless would be understood to mean a clear layer, i.e. a layer that would have a total light transmittance in the visible inherently greater than 60%. The keycoat of Hephher et al equivalent to the adhesive layer of the instant laminate. It must be light transmissive enough not to muddy the color of the photosensitive material to be dyed and the base is disclosed to be transparent or translucent. Thus, with respect to instant claims 1-3, 7, 11-13 and 17, the photosensitive sheet product of Hephher et al when chosen to be colorless makes obvious the instant laminate and plate wherein coloration either by dyeing the processed sheet or painting the process sheet as desired before transfer onto a carrier sheet.

7. Applicant's arguments filed December 3, 2003 with respect to Hephher et al have been fully considered but they are not persuasive. Applicants argue only about the translucent base of Hephher. There is no recognition in applicants' arguments of the transparent bases also taught by Hephher. The desire for a clear layer by Hephher would lead to the laminate with a total light transmittance in the visible of greater than 60%. At what point there is clarity and not clarity with respect to total light transmittance has not been addressed by applicants. The desire for a clear element in Hephher et al is held to yield inherently the instant element. Hephher et al would have desired as little interference with the color to be added as possible. Thus, applicant's failure to show how "clear" is different than an element with total light transmittance greater than 60 % is why Hephher et al rejections are maintained. Some understanding that a clear laminate could have a total light transmittance less than 60% would allow this examiner to understand why applicants believe that some scope of their elements is not taught by Hephher et al.

8. Claims 6, 16 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff, can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CYNTHIA HAMILTON
PRIMARY EXAMINER

Cynthia Hamilton
Primary Examiner
Art Unit 1752

February 15, 2004